THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 63

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JACQUES GIGNAC,
PATRICE MAUREL, and ARNAUD RISBOURG

Appeal No. 1997-2818
Application 08/322,370[1]

HEARD: Nov. 3, 1999

Before McCANDLISH, Senior Administrative Patent Judge, FRANKFORT and MCQUADE, Administrative Patent Judges.

McCANDLISH, Senior Administrative Patent Judge.

DECISION ON APPEAL

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[1] Application for patent filed October 13, 1994. According to appellants, this application is a continuation of Application 07/533,761, filed June 6, 1990, now abandoned.

This is a decision on an appeal from the examiner's final rejection of claims 1 through 4, 6 through 12 and 17. No other claims are pending in the application.

Claim 4 was amended in a paper accompanying appellants' main brief to correct a typographical error. In addition, claims 1 and 17 were amended in a paper accompanying appellants' reply brief in response to a new ground of rejection (under 35 U.S.C.
§ 112, second paragraph) introduced in the examiner's answer. The amendment to claim 1 deletes the phrase "and against" in the passage "first means . . . for displacing its respective one of the sheet-holding devices . . . towards and against the other sheet-holding device . . ."

As a result of the amendment accompanying the reply brief, the examiner withdrew the new ground of rejection. In his answer, the examiner withdrew the final rejection of the appealed claims under 35 U.S.C. § 112, first paragraph. Thus, the only issue remaining in this appeal is the propriety of the standing rejection of the appealed claims under 35 U.S.C. § 103.

The claimed invention relates to a tool assembly for drilling and riveting parts (claims 1 through 4, 6 through 8, 10 through 12 and 17) and to a process (claim 9) for assembling, drilling and riveting parts. The independent claims on appeal, namely, claims 1 and 9, call for "a pair of sheet [sic]-holding devices" for holding the parts or workpieces (7, 8) to be riveted together, a drill (21) for drilling the rivet-receiving holes in the parts (7, 8) and the apparatus for riveting the two parts together, namely, a percussion riveting hammer (50, 51) and a counter-piece (54). Both of the independent claims also recite, inter alia, that "the sheet-holding device which is opposed to the drill [has] vents for discharging chips."

With regard to the copy of the appealed claims appended to appellants' brief, the reproduction of claims 1 and 17 is no longer correct in light of the amendment that accompanied appellants' reply brief.

The following references are relied upon by the examiner as evidence of obviousness in support of his rejection under 35 U.S.C. § 103:

Gutnik	4,815,193	Mar. 28, 1989
Stoewer	4,854,491	Aug. 8, 1989

Bonomi et al. (Bonomi)	4,885,836	Dec. 12, 1989
Rydstrom et al. (Rydstrom)	4,919,321	Apr. 24, 1990

Claims 1 through 4, 6 through 12 and 17 stand rejected under 35 U.S.C. § 103 as being unpatentable over Stoewer in view of Rydstrom, Bonomi and Gutnik. According to the examiner's findings, Stoewer differs from appellants' claimed invention in the following respects:

> Stoewer . . . **lacks** the specific type of riveting tools including a percussion riveting hammer and an appropriate cooperating counterpiece for such a riveting operation. Stoewer also **lacks** a first means provided on each of the first and second frames for displacing its respective one of the sheet-holding devices towards and against the other sheet-holding device, sensor means provided on each sheet-holding device, and vents in one of the sheet-holding devices for discharging chips. [emphasis in original; answer, page 6.]

The examiner concludes, however, that the teachings of Rydstrom would have made it obvious to employ a riveting hammer as the riveting tool in Stoewer's apparatus, that the teachings of Bonomi would have made it obvious to provide Stoewer's apparatus with a sensor corresponding to appellants' claimed sensor means and further with a force applying device corresponding to appellants' claimed first means, and that the

teachings of Gutnik would have made it obvious to provide chip-discharging vents in one of Stoewer's sheet-holding devices.

Although we cannot accept several arguments made by appellants in their briefs,[2] we nevertheless cannot sustain the § 103 rejection of the appealed claims. Both of the independent claims 1 and 9 recite that the counter-piece is integral with a reaction dolly (52) (described as "a mass of high inertia" on page 1 of appellants' specification) as well as reciting a means including a fluid actuated cylinder (53) for displacing the counter-piece between an active position and a rest position.

The Rydstrom patent does not disclose such a reaction dolly, let alone a riveting tool in which the counter-piece is

[2] For example, appellants argue on page 8 of the main brief that "indeed there is no teaching in any of the prior art concerning percussion riveting in any context" (emphasis added). However, the discussion of the admitted prior art on page 1 of appellants' specification states that "deformation of the rivet can be effected by hammering or by pressing" and that "[i]n the case of hammering, a mass driven at a certain speed repeatedly strikes the end of the rivet . . ." Furthermore, it appears from page 3 of the reply brief that appellants do not take issue with the examiner's position that Rydstrom discloses a percussion hammer and counter-piece.

integral with the reaction dolly. In addition, the Rydstrom patent lacks a teaching of a fluid actuated cylinder for displacing a counter-piece between an active position and a rest position. Instead, Rydstrom discloses a bucking bar to absorb the impacts of the rivet-upsetting hammer.

Thus, even if it would have been obvious to replace Stoewer's riveting tool with Rydstrom's riveting tool, the result would not meet the terms of claims 1 and 9. To do so, it would be necessary to make a modification of the initial modification (i.e., the combined teachings of Stoewer and Rydstrom). The examiner, however, has not stated why it would have been obvious to further modify the riveting tool to provide a reaction dolly, a counter-piece integral with that dolly and a fluid actuated cylinder for displacing the integrally connected counter-piece between the active and rest positions as defined in the independent claims on appeal. Furthermore, there is no evidence that there is any problem with the discharge of chips in Stoewer's drilling operation to warrant the provision of "vents" in one of Stoewer's sheet-holding devices.

In the final analysis, the only way the examiner could have arrived at appellants' claimed invention is through hindsight based on appellants' teachings. Hindsight analysis, however, is clearly improper. In re Deminski, 796 F.2d 436, 443, 230 USPQ 313, 316 (Fed. Cir. 1986).

The examiner's decision rejecting appealed claims 1 through 4, 6 through 12 and 17 under § 103 is reversed.

REVERSED

Harrison E. McCandlish, Senior Administrative Patent Judge	)	
Charles E. Frankfort Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
John P. McQuade Administrative Patent Judge	)	

tdl

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